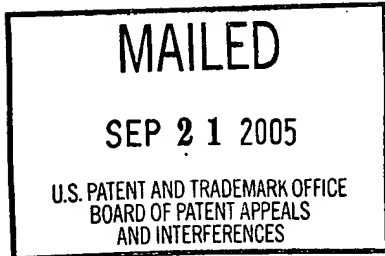


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte OCTAVIUS J. MORRIS and TIMOTHY J. EVERETT

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Appeal No. 2005-1858  
Application No. 09/172,435<sup>1</sup>

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ON BRIEF

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Before BARRETT, RUGGIERO, and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 4-7 and 9-22. Claims 2, 3 and 8 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to formatting of predictive-encoded digital video signals on a recording medium. The use of the so-called trick mode or forward and reverse

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<sup>1</sup> Application for patent filed October 14, 1998, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of British Application No. 9721662.6, filed October 14, 1997.

playing becomes problematic as it is only possible to start decompressing at points where the I-frames do not rely on information from prior to the access point (specification, page 2). In order to identify the I-frames, additional data blocks are inserted in the data block stream wherein each additional block carries data for facilitating the identification of an I-frame (specification,, page 3).

Representative independent claim 1 is reproduced below:

1. A method for formatting a sequence of video images comprising the steps of:

encoding successive images of the sequence according to a predetermined coding scheme in which some images of the sequence are intra-coded, without reference to any other image of the sequence, and the remainder are respectively coded with reference to at least one further image of the sequence;

formatting the encoded data for each image into one or a sequence of data blocks and outputting a data block stream formed of the data block or blocks from successive ones of the sequence of video images, said formatting including formatting at least one image of the sequence into a plurality of data blocks;

characterized in that the step of formatting comprises the further steps of identifying intra-coded frames and of inserting additional data blocks in said data block stream at fixed periodically repeated intervals, each of said additional data blocks carrying data identifying the relative location in the data block stream of the first or only data block in the data block stream of the closest previously formatted intra-coded image frame.

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The Examiner relies on the following references:

Jain	5,249,053	Sep. 28, 1993
Kawamura et al. (Kawamura)	5,621,840	Apr. 15, 1997

Claims 1, 4-7 and 9-21 stand rejected under 35 U.S.C.  
§ 103(a) as being unpatentable over Kawamura.<sup>2</sup>

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

#### OPINION

The Examiner relies on Kawamura for teaching the claimed features except for disclosing that additional data blocks are inserted at fixedly repeated intervals (final, page 4). The Examiner asserts that the entry packets of Kawamura (Figure 10) are the additional data blocks that are inserted before the video packet header for a packet of data containing an I picture (final, page 5). The Examiner further reasons that if a fixed compression rate is used, the I frames may be located at

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<sup>2</sup> The 35 U.S.C. § 103(a) rejection of claim 22 over Kawamura and Jain was withdrawn by the Examiner (answer, page 7).

predetermined positions in the video stream and therefore, the data blocks or entry packets will be inserted at fixed repeated intervals (id.). The Examiner specifies removing the need for circuitry for calculating the position of entry points as the reason for modifying Kawamura (id.).

Appellants argue that Kawamura merely teaches that if the position of the I frames prior to compression are predetermined, their position following compression are likewise known (brief, page 7). Appellants further point out that however, "predetermined positions" does not mean "fixed periodically repeated intervals," as recited in claim 1 (id.). Additionally, Appellants argue that the disclosed invention of Kawamura is based on using a variable compression rate which results in unknown positions of I frames (brief, page 8) and would not work without a variable compression rate (brief, page 9). With respect to the additional data blocks, Appellants argue that in Kawamura, their position would have to be calculated instead of those of the I frames (brief, page 9).

In response to Appellants arguments, the Examiner asserts that Kawamura describes fixed compression rate wherein the positions of I pictures can be determined by calculation since they cyclically appear at predetermined positions (answer, page

4). The examiner further argues that since Kawamura teaches "inserting the additional data packets (or entry packets) ... and the I pictures cyclically appear at predetermined positions when the compression rate is fixed" (answer, page 5), the entry packets are added at a fixed periodically repeated intervals. Additionally, the Examiner acknowledges that Kawamura does not teach the application of entry point packets when compression rate is fixed, but reasons that such addition allows points of video data to be quickly located (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Our review of Kawamura confirms that the reference relates to video data transmission in MPEG which includes bit stream of I, P and B pictures divided into one or more Group of Pictures (GOP) (col. 3, lines 13-24). As pointed out by Appellants and the Examiner, in the case of fixed rate compression, I pictures cyclically appear at predetermined positions, determined by calculations, which become access points (id.). However, when variable rate compression is used, a search operation becomes necessary that skips data to find the next I picture (col. 3, lines 46-56).

While not appreciating the full extent of the reference teachings, the Examiner does identify the entry packets depicted in Figure 10 as additional data blocks inserted in the data block stream (answer, page 5). We also observe that Kawamura discloses that on the basis of the detected first entry point, packets including position information relating to at least one second entry point are inserted (col. 4, lines 3-13) at a predetermined position of bit stream (col. 6, lines 4-9). Further, the reference teaches that immediately before the video data

including I picture or the entry point, the packet designated as "Entry\_Packet" is allocated (Fig. 9; col. 6, lines 36-38) which contains information related to the previous and the future entry points ( Fig. 10; col. 7, lines 26-37). However, as pointed out by Appellants, the insertion of entry packets relates to variable rate compression wherein the location of I pictures cannot readily be determined or do not necessarily occur at fixed periodically repeated intervals.

It is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). As the court in Uniroyal, 837 F.2d at 1051, 5 USPQ2d at 1438 stated, "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

Absent Appellants' own disclosure, we can think of no reason why one of ordinary skill in this art would have been motivated to modify the disclosure of Kawamura as the Examiner has proposed. Here, the teachings directed to the fixed rate compression indicate that there is no need for inserting

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additional blocks since I pictures appear at predetermined positions. However, the additional entry packets are included in the video data when the compression rate is variable and the I picture positions are not defined (col. 3, lines 13-24). In that regard, the Examiner relies on disparate features of the embodiments described in the background section of the reference, which are actually at odds with each other, to justify modifying the way the entry packets are inserted. Therefore, we find no teaching or suggestion for combining these portions of Kawamura, as set forth by the examiner, to successfully arrive at Appellants' claimed invention. Therefore, as the Examiner has failed to set forth a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 1, 4-7 and 9-21 over Kawamura cannot be sustained.



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## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 4-7 and 9-21 under 35 U.S.C. § 103 is reversed.

REVERSED

Lee E. Barrett

LEE E. BARRETT  
Administrative Patent Judge

Joseph F. Russo  
JOSEPH F. RUSSO

JOSEPH F. RUGGIERO  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

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